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Application No. 09/740,209

REMARKS

In an Office Action dated July 24, 2006, claims 1-7, 9-17, 19, 21 and 22 were objected to because the Examiner maintained that it was unclear whether the pharmaceutical product was actually being claimed. Examiner considered the pharmaceutical product to be positively recited as an element. Applicant submits that although the device is designed to deliver a pharmaceutical product, and thus has the design parameters for delivering a pharmaceutical product, a pharmaceutical product need not be physically present in the device to be covered by the claim. Applicant has added new claim 26 that positively recites the pharmaceutical product and is structured such that the pharmaceutical product is in the device.

The claims 1-7, 9-17 and 21-25 were rejected under 35 U.S.C. 102(f) because it was claimed the Applicant did not invent the claimed subject matter. Instead to overcome the rejection, it was suggested that Applicant submit at 1.131 or a 1.132 affidavit. Applicant believes that such an affidavit is inappropriate. A 1.131 affidavit is to overcome a rejection based on a cited prior art reference by claiming invention prior to the cited prior art reference. In this case, both applications were filed on the same day, thus the "other reference" was not filed prior to the filing of the subject application.

MPEP section 2137.01 citing *Driscoll v. Cebalo*, 5 USPQ2d 1477, 1481 (Bd. Pat. Inter. 1982) states that when a declaration is filed with the application pursuant to 37 CFR 1.63, the signatories are entitled to a presumption that they are the inventors. In the subject application, a declaration was submitted on May 31, 2001 in response to a Notice of Missing Parts. The declaration signed by the three inventors states that they believe they are the first, original and joint inventors of the subject application. Thus Applicant respectfully submits that it is entitled to a presumption that the three signatories are the inventors.

Furthermore, the cited "prior art" reference was (1) filed by the same assignee on (2) the same date as the current application and (3) lists as its sole inventor one of the

Application No. 09/740,209

inventors of the current application, thus the inventorship of that reference is a subset of the three inventors on the present application. Thus there is no conflict in inventorship.

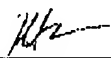
The inventors are no longer with the assignee, thus Applicant cannot, without great effort, easily contact the inventors and respectfully submits that such contact is unnecessary in view of the above, especially in view of the presumption that they are inventors by virtue of the previously executed declaration.

In view of the preceding amendments and remarks, Applicant respectfully submits that the claims as amended are allowable over the cited prior art reference, and allowance is hereby respectfully requested.

No additional fee is believed to be required for this amendment. However, the undersigned Xerox Corporation attorney (or agent) hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

In the event that the Examiner believes a teleconference would facilitate prosecution, Applicant respectfully requests that Examiner contact the undersigned.

Respectfully submitted,



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